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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,091	08/28/2003	Asta Khavakh	N0172 US	7735

37583 7590 03/09/2005

NAVIGATION TECHNOLOGIES  
222 MERCHANDISE MART  
SUITE 900, PATENT DEPT.  
CHICAGO, IL 60654

EXAMINER

NGUYEN, THU V

ART UNIT PAPER NUMBER

3661

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/651,091

Applicant(s)

KHAVAKH ET AL.

Examiner

Thu Nguyen

Art Unit

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24 and 31-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24 and 31-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

The amendment filed on December 16, 2004 has been entered. By this amendment, claims 1-23, 25-30, 41-44 have been canceled, and claims 24, 31-40 are now pending in the application. The terminal disclaimer submitted on December 16, 2004 has been approved.

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 24 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of the prior U.S. Patent No. 6,298,303 issued to Khavakh et al (patent'303 hereinafter). This is a statutory double patenting rejection.

Claim 24 claims the same subject matter taught in claim 1 of the patent'303. The amended language in claim 24 appears just overcoming the 112 second paragraph rejection issued in the Office Action on September 13, 2004 on ambiguity of the claimed language, however, the amended elements does not make the scope and inventive subject matter of claim 24 different from the scope of claim 1 of patent'303. Specifically, the amended language "that includes a selection of said road" in line 9 of claim 24 clarifies the fact that the list contains the selected road segment records, however, the "list" containing the selected road segment records in claim 24 should not be different from the "list" disclosed in claim 1 of patent'303; the components contained in the list in claim 24 and the components contained in the "list" in claim 1 of patent'303 should be the same because lines 10-13 of claim 24 teaches the same selection procedure as the selection procedure taught in lines 11-15 of claim 1 of patent'303. Furthermore, the amended language "road segment records" in lines 13 and 16 just clarify that the road segments are the "road segment records" (not the selected road segments records taught in line 9); it appears that the amended language does not mean that the "road segment records" in lines 13 and 16 of claim 24 are different from the "road segments" taught in lines 16 and 19 of patent'303.

***Allowable Subject Matter***

3. Claims 24, 31-40 are allowed over prior arts if the statutory double patenting is overcome.
4. The following is a statement of reasons for the indication of allowable subject matter:

Prior arts of record do not disclose a method for providing real time traffic weighted routes taught in claim 24 in which the weighting applicable to roads in the road network is transmitted wirelessly, the weightings are used for selecting route segments that form a solution route including a list of selection of the road segment records; the process for selecting the solution route segment records using a search tree and gates are taught in detail in claim 24.

***Response to Arguments***

Applicant's argument concerning claims 24 over 35 USC 103 issue is moot in view of the indication of allowability over prior arts. However, the statutory double patenting of claim 24 remain. Refer section 1. above for detail explanation. The terminal disclaimer submitted on December 16, 2004 has been accepted. However, the terminal disclaimer cannot overcome the statutory double patenting of claim 24.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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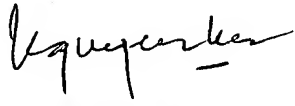
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Nguyen whose telephone number is (703) 306-9130. The examiner can normally be reached on T-F (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on (703) 305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 4, 2005

  
**THU V. NGUYEN**  
**PRIMARY EXAMINER**